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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,516	05/31/2000	MICHAEL L EMENS	AM9-99-0118	2490

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EXAMINER	
ALVAREZ, RAQUEL	

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/583,516	EMENS ET AL.	
	Examiner	Art Unit	
	Raquel Alvarez	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-23 and 25-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3, 5-23 and 25-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This office action is in response to communication filed on 9/24/2003. Claims 1-3 and 5-23 and 25-37 are presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2-3 5-12, 15-20, 22-29, 31-36 rejected under 35 U.S.C. 102(b) as being anticipated by Skillen et al.(Wo 98/36366, hereinafter Skillen).

With respect to claims 1, 3, 22, Skillen teaches a method for targeting an associated advertisement from an Internet search having access to an information repository by a user (Abstract). Identifying at least one search result item from a search result of said Internet search by said user (i.e. a traditional keyword search in the Internet produces a search result and the associated keyword is used to match the keyword to a product data 24 of database 20)(page 7, lines 16-25); searching for said at least one associated advertisement within said repository using said at least one search result item (page 7, lines 16-25); identifying said associated advertisement from said repository having a word that matches said at least one search result item (page 7, lines 16-25); and

correlating at least one said advertisement with said at least one search result item (page 7, lines 16-25).

With respect to claims 2, 5 and 23, Skillen further teaches providing the advertisement on demand by said user (page 8, lines 12-22).

With respect to claims 6 and 26, Skillen teaches designating user search result items matched to said associated advertisements for subsequent selection by user (page 7, lines 34-, page 8, lines 1-3).

With respect to claims 7-12, 27-29 Skillen further teaches submitting a query to said information repository and obtaining said individual search result items as an URL (page 7, lines 34, page 8, lines 1-3).

With respect to claims 16, 18, 31 and 35-36 Skillen teaches providing related advertisements for search result items from a search of an information repository (Abstract). A computer readable program code means for causing a computer to effect matching said result items to said related advertisements (page 7, lines 34-, page 8, lines 1-3); a computer readable program code means for causing a computer to effect designating each of said search result items that have said related advertisements matched therewith(page 7, lines 34-, page 8, lines 1-3); a computer readable program code means for causing a computer to effect providing a corresponding graphical user interface for each of said search result items so designated for subsequent selection by a user (i.e. the user can click on the search results); a computer readable program code means for causing a computer to effect searching and retrieving said related advertisements for one of said search result items when said corresponding

graphical user interface is selected by said user (page 7, lines 34-, page 8, lines 1-3); and a computer readable program code means for causing a computer to effect formatting and displaying said related advertisements upon selection (page 7, lines 34-, page 8, lines 1-3).

With respect to claim 15 and 19, Skillen further teaches that the user interface comprises a product icon (page 8, lines 12-22).

With respect to claim 17, Skillen further teaches assigning an identifier for said user when said user submits a query to said information repository (page 8, lines 12-22).

Claim 20 is similar in scope as claims 9-12 and therefore rejected under similar rationale.

With respect to claim 25, Skillen further teaches displaying along with said search result a user-selectable icon containing a link to said associated advertisement (page 6, lines 35-, page 7, lines 1-9).

With respect to claims 32-34, Skillen further teaches formulating a list of the related advertisements and passing the list to the request server (page 9, lines 9-36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 13, 14, 21, 30 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen.

With respect to claim 13, 21 and 30, the claims further recite an off-line batch process for identifying said related advertisements for said search result items. Skillen teaches on page 8, lines 23-33 maintaining a database of the search results for the users in order to find the best fit product advertisement for the user. Skillen doesn't specifically teach that the process is conducted off-line. Official notice is taken that off-line processing its old and well known. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included processing the information off-line because such a modification would allow for the information to be analyzed at a later time.

Claim 14 further recites providing a true/false designator to a user indicating whether said related advertisements exist for said individual search results items. Since, Skillen teaches advertisements based on the individual search results items (see abstract and drawings) then it would have been obvious to a person of ordinary skill in the art a the time of Applicant's invention to have included providing a true/false to the user if said related advertisements exist because such a modification would give the users a definite response that advertisements based on the search criteria used does or doesn't exist.

Claim 37 further recites assigning an identifier for said user when said query is submitted to said information repository. Official notice is taken that it is old and well known to assign identifiers in order to differentiate items or persons.

For example, a user is given a social security number to identify a particular person. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included in the user's query submitted to said information repository of Skillen to assign an identifier because such a modification would provide the above mentioned advantage.

Response to Arguments

4. The 112, first paragraph rejection has been withdrawn.

5. With respect to Applicant's arguments that Skillen does not teach "searching for said at least one associated advertisement within said repository using at least one search result item". The Examiner respectfully disagrees with Applicant because when an item is searched, the result of the search for that item will produce a result consisting of the item that was searched plus other information pertaining to that item. In Silken the search argument is part of the result of the search and then the result in which the search argument is part of selects a probable best product for an advertisement window to be displayed with the search result (page 7, lines 16-21).

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the initial search argument is not at least one search result item) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Even if

this limitation was to be present in the claims, Skillen teaches that the associate search engine 18 will further refine its logical tree strategy and selects the probable best fit product and generates an advertisement based on the specific search result (in Skillen page 7, lines 36-, col. 8, lines 1-22).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Point of contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Raquel Alvarez
Examiner
Art Unit 3622

R.A.
11/17/03

ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600